

Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 12 of 14

Attorney's Docket No.: 07844-235001 / P212

REMARKS

Claims 1-7, 9-25, 27-37, and 39-47 are now pending in the application. Each of independent claims 1, 9, 16, 17, 18, 37, 39, 40, 41, 42, and 43 has been amended. No new matter has been added. Reconsideration and reexamination are respectfully requested in view of the amendments and the following remarks.

Claim Rejections 35 USC § 112

The Examiner rejected independent claims 17, 18, 41, and 42 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner specifically indicated that the claims were vague and unclear as to what in the claims were "complete in themselves."

Claims 17, 18, 41, and 42 have been amended to clarify that it is *the document states that* are complete in themselves. The claims have also been amended to clarify that the document states are complete in themselves "in the sense that earlier document states in the history can be deleted without adverse affect", as explained in the specification at page 12, lines 1-3. The applicants respectfully submit that, as amended, claims 17, 18, 41, and 42 are not indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and that the Examiner's rejection of these claims is thereby overcome.

Claims 19-21 depend from claim 18. The Examiner indicated that claims 17-21, 41, and 42 will be allowed when the 35 U.S.C. § 112 is overcome. The applicants respectfully submit that amended claims 17-21, 41, and 42 are allowable, and earnestly request that claims 17-21, 41, and 42 be allowed.

Claim Rejections 35 USC § 103

The Examiner rejected independent claims 1, 9, and 39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,828,375 ("Nomura") in view of U.S. Patent No. 6,185,591 ("Baker"). The Examiner rejected independent claims 22 and 43 as being unpatentable over

Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 13 of 14

Attorney's Docket No.: 07844-235001 / P212

Nomura and Baker in view of U.S. Patent 6,310,630 ("Kulkarni et al."), although the Examiner discussed only Nomura with respect to claim 22. The Examiner did not explain the basis for rejection of independent claims 16, 37, or 40, but such basis is presumed to be similar to the basis for rejection of claims 1, 9, and 39.

Each of these remaining independent claims is now amended to indicate that the pertinent document state is "*complete in itself*" and to indicate the meaning of the phrase "*complete in itself*". In particular, claims 1 and 37 are amended to indicate that the state of the document is "*complete in itself in the sense that earlier document states in the state history of the document can be deleted without adverse affect*". Claims 9 and 39 are amended to indicate that a changed document state is "*complete in itself in the sense that older document states in the state history of the document can be discarded without adverse affect*". Claims 16 and 40 are amended to indicate that each state in the state history is "*complete in itself in that any state in the state history can be deleted without adversely affecting any other state in the state history*". Claims 22 and 43 are amended to indicate that each of the states that a document has been in is "*complete in itself in the sense that any earlier state in the history can be deleted without adverse affect*".

As discussed in previous correspondence regarding this application, each of these independent claims – namely, claims 1, 9, 16, 22, 37, 39, 40, and 43 – also indicates that the pertinent document states are automatically captured or maintained by, or created by operation of, an application in response to a user command or action.

The applicant respectfully submits that none of the references cited by the Examiner, either alone or in combination, describes or suggests a state history of a document where the document states are "*complete in themselves*" and are automatically captured or maintained by, or created by operation of, an application in response to a user command or action, as recited by each of these independent claims. For at least this reason, the applicant respectfully submits that independent claims 1, 9, 16, 22, 37, 39, 40, and 43 are not obvious and are allowable.

Allowance of amended independent claims 1, 9, 16, 22, 37, 39, 40, and 43 is therefore earnestly solicited.

Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 14 of 14

Attorney's Office No.: 07844-235001 / P212

Each of the remaining claims – claims 2-7, 10-15, 23-25, 27-36, and 44-47 – depends from one of claims 1, 9, 16, 22, 37, 39, 40, and 43, and is allowable for at least the reasons that the claim from which it depends is allowable, as discussed above. For at least such reason, the applicant respectfully submits that dependent claims 2-7, 10-15, 23-25, 27-36, and 44-47 are allowable.

Allowance of dependent claims 2-7, 10-15, 23-25, 27-36, and 44-47 is therefore and also earnestly solicited.

No fees are believed to be due. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: July 19, 2004



Tamara Fraizer
Reg. No. 51,699

Fish & Richardson P.C.
500 Arguello Street, Suite 500
Redwood City, California 94063
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50216158.doc